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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/582,451

07/19/2006

James John Schmitt

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AKZO NOBEL INC.

LEGAL & IP

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EXAMINER

MCGUTHRY BANKS, TIMA MICHELE

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

01/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,451	Applicant(s) SCHMITT ET AL.	
	Examiner TIMA M. MCGUTHRY-BANKS	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1, 3, 5 and 6 are currently amended, Claim 2 is as originally filed, Claims 4, 7 and 8 are as previously presented and Claim 9 is new.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (US 3,554,792).

Johnson teaches a binder comprising an alkali metal silicate and sodium carboxymethyl cellulose (abstract). The limitation of the binder being suitable for producing iron ore agglomerates is intended use; language in the claim that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation, for example statements of intended use or field of use. See MPEP § 2106. Regarding Claim 8, the alkali metal is sodium (column 5, line 11).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 1, 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cobett (US 6,743,275 B1).

Cobett is applied as discussed in the office action mailed 1 August 2008. Regarding Claim 9, water is an inorganic binder (column 2, line 22).

Claims 1, 3, 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field et al (US 6,293,994).

Field et al teaches making fire mineral pellets. The pellets include alkali metal silicate in an amount above 0.08% (abstract). The pellet also includes cellulosic polymers (column 3, lines 5 and 6). Regarding Claims 1 and 3, Field et al does not teach the claimed range. However, a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. See MPEP § 2144.05 I. Regarding Claim 4, the alkali metal is sodium (column 4, line 2). Regarding Claim 9, Field et al teaches an organic polymer (column 1, line 54).

Claims 2 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field et al as applied to claim 1 above, and further in view of Allen et al (US 4,728,537).

Field et al discloses the invention substantially as claimed. The rejection of Claim 6 is incorporated above for the rejection of Claim 1. Regarding Claim 7, the alkali metal is sodium. Though Field teaches using cellulosic polymers, Field et al does not specifically disclose using carboxymethyl cellulose as in Claim 2.

Allen et al teaches pelletizing ore. Though Allen et al teaches "a difficulty with powdered cellulosic binders such as carboxymethyl cellulose" in column 2, lines 66 and 67, Allen et al teaches nonetheless that carboxymethyl cellulose is a type of cellulosic binder.

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According to MPEP § 2141.03, a prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention. It would have been obvious to one of ordinary skill in the art at the time the invention was made to expect that the cellulosic binder in Field et al could be carboxymethyl cellulose, since Allen et al exemplifies such in an agglomerated iron ore pellet.

Response to Arguments

Applicant's arguments with respect to the rejections over Pietoch et al (US 4,105,457) and Pietoch et al (US 4,116,679) are persuasive and are therefore withdrawn.

Regarding the rejection over Johnson, applicants claim a binder system "suitable for ..." This limitation is intended use, as explained above. Additionally, because the composition in Johnson is the same as claimed, it would be capable of performing the same intent. The percentages are not claimed.

Regarding the rejection over Cobett, the disclosed amount of sodium silicate incorporates the entire range of at most 10%. Cobett does not teach any lower limit of alkali metal silicate. Patents are relevant as prior art for all they contain: A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. Additionally, nonpreferred and alternative embodiments constitute prior art; disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See MPEP § 2123.

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Regarding the rejection over Field et al, a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. See MPEP § 2144.05 I.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMA M. MCGUTHRY-BANKS whose telephone number is (571)272-2744. The examiner can normally be reached on M-F 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art Unit
1793

/T. M. M./
Examiner, Art Unit 1793
13 January 2009